

PATENT
Application 10/064,251
Attorney Docket 2001-0337 (1014-284)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1, 6, and 10 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 6, and 10 is in independent form.

I. The Statutory Subject Matter Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, and thus was asserted to be unpatentable. Each of these rejections is traversed as moot in view of the present amendments to each of claims 1, 6, and 10, which now recite "a predetermined node in the mesh telecommunication network".

For at least these reasons, reconsideration and withdrawal of each of the rejections of claims 1, 6, and 10 is respectfully requested. Also, reconsideration and withdrawal of each rejection of each of claims 2-5, 7-9, and 11-20, each of which ultimately depends from one of independent claims 1, 6, and 10, is also respectfully requested.

II. The Obviousness Rejections

Each of claims 1-5 and 16-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent Publication 20010032271 ("Allen"), U.S. Patent 5,856,981 ("Voelker"), U.S. Patent 6,366,761 ("Montpetit"), U.S. Patent 6,741,572

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("Graves"), and/or a paper "ReSerVation Protocol with Traffic Engineering Extensions", April 2001 ("Kini"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. "Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known" (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. "Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility" (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art". Thus, in determining obviousness, both *KSR* and *Graham* warned against a "temptation to read into the prior art the teachings of the invention in issue" and instruct to "guard against slipping into the use of hindsight".

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KSR further warned, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. The Federal Circuit has held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “would convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358 (Fed. Cir. 2008).

To guard against hindsight, *KSR* explained the “import[ance]” of “identify[ing] a reason that would have **prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “a reason that would have prompted a person of ordinary skill”, *KSR* further taught that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

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1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

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3. Inherency

Inherency “requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

4. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

5. Interpreting “adapted”

The predecessor court to the Federal Circuit has interpreted the phrase “adapted” as preceding a “structural limitation”. *See, In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by “adapted” have been considered sufficiently definite. *See* MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word “adapted” as preceding “functional language [that] **limits** the scope of these claims to devices that have the capability of” performing the stated function. *See, R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term “adapted.”

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated “said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred.” *See, In re Land*, 368

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F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

In yet another case, the Federal Circuit reversed an Examiner's rejection of a patent claim due to the Examiner's failure to provide patentable weight to **functional limitations**. *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

6. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

B. Analysis

1. All Claims – Limitations Prefaced by "Adapted"

The present Office Action asserts, with no legal basis whatsoever, regarding claim 1, **"reciting an element is 'adopted to' [sic] perform a function is not a positive limitation but only requires the ability to so perform. The phrase 'adopted to' [sic] does not constitute a limitation in any patentable state)."**

This assertion is traversed as utterly lacking any legal basis whatsoever. To the extent that any of claims 1-20 are rejected based upon this assertion of the present Office Action regarding claim 1, Applicant respectfully traverses and requests a proper examination of the claim subject matter in accordance with the requirements of *In re Venezia, R.A.C.C. Indus., Inc.*, *In re Land*, and *In re Mills*.

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2. Claims 1-5 and 16-20

a. Inherency

The present Office Action states, regarding claim 1:

Voelker discloses ... sending a release request to a plurality of nodes along the restoration path, the release request adopted to cause a release of a restoration path resource allocation, the label switched path switched responsive to a repair of a failure at least one component comprised by the service path (See Column 5, Lines 56-67 - the owner of the connection, i.e. the originating node, can trigger the allocation and deallocation procedure and inherently involves some form of release request message being sent along the nodes defining the path as illustrated in Column 3, Lines 31-35)".

See, Page 5.

No substantial evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Voelker. Applicant respectfully requests provision of evidence supporting the assertion that **"the owner of the connection, i.e. the originating node, can trigger the allocation and deallocation procedure and inherently involves some form of release request message being sent along the nodes defining the path."**

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses as improperly supported, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the "missing descriptive material is necessarily present, not merely probably or possibly present", in any prior art reference cited to support such rejection.

b. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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c. Missing Claim Limitations

Claim 1 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, a “responsive to a determination that the label switched path has been switched to the service path, sending a release request to a plurality of nodes along the restoration path, the release request adapted to cause a release of a restoration path resource allocation, the label switched path switched responsive to a repair of a failure of at least one component comprised by the service path, the release request an RSVP-TE protocol request comprising a shared reservation flag adapted to cause the release of the restoration path resource allocation without causing a release of reserved resources associated with the restoration path and without causing a removal of the restoration path”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested. Also, reconsideration and withdrawal of each of claims 2-5 and 16-20, each of which ultimately depends from claim 1, is also respectfully requested.

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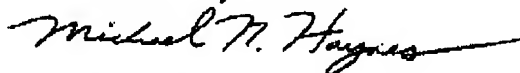
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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